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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,261	07/13/2001	John MacAlister	1965-1-3	4870

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EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,261

Applicant(s)

MACALISTER ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9,14-18,25-28 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,14-18,25-28 and 31-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Rejections Maintained

1. Claims 25- 28, 33-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkins (6038803) for reasons of record in the last Office Action of May 25, 2005.
2. Claims 1, 4-8, 16-18 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins for reasons of record made in the last Office Action.
3. Claims 14-15 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins for reasons of record made in the last Office Action.

Response to Arguments

4. Applicant's arguments filed August 8, 2005 have been fully considered but they are not persuasive.

Applicant argues that Wilkins does not teach a soft mount exhibiting cling properties and which is pre-coated with adhesive on one side. This is not deemed to be convincing because, as clearly taught by Wilkins in col. 3, lines 59-60, the PVC static cling sheet D is secured to the picture B using tacky adhesive. This shows the presence of adhesive on one side of the PVC static cling sheet or mount. Similarly, in col. 4, lines 28-36, Wilkins also teaches that the cling sheet E is electrostatically adhered to a protective backing F and optionally, a tacky adhesive is provided to adhere the sheet E to the original picture. This also shows that the cling PVC sheet is adhesively adhered to the

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picture with adhesive being provided on one side and the other side is electrostatically adhered to the backing F.

Applicant's argument about claims 2 and 3 is noted, However, no response is deemed necessary by the examiner in view of said claims being cancelled by the applicant.

Regarding the 35 USC 103(a) rejection, it is argues that applicant fails to comprehend the difference in the language between the Longtin patent and the present application.

This is not deemed to be persuasive because each application are examined on its own merits. Applicant is informed that language may appear to be same in other patents but may have different understanding when interpreted in the context of the specific subject matter.

Further, the amendment to the claims to recite "a mount or mounts" continues to be obvious over Wilkins in view of the obvious duplication of parts as mentioned in the last Office Action of May 25, 2005, paragraph-10.

Contrary to applicant's allegation, the intended use phrases were not objected to but were not given any patentable weight because said phrases were directed to intended future use of the product as claimed.

Applicant argues that the claimed size of the instant mounts are the deliberate result of experimentation to optimize the dimension of the mounts. However, applicant has failed to show any evidence that Wilkins mount would not function when its dimension is optimized.

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Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed above.

Indicated Allowability Withdrawn

5. Indicated allowability of claim 9 is has been withdrawn in view of applicant's admission in the amendment filed on August 8, 2005. New grounds of rejection on the merits follows:

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treglown (GB: 2333050) in view of Applicant's Admission.

Treglown relates to a tab or mount having adhesive on one surface and the tab is formed of PVC or polyethylene. However, Treglown fails to teach that the PVC has static cling property. Applicant admits, in the amendment filed on August 8, 2005, particularly in claim 1, that it is well known for PVC to have static cling property.

Therefore, it would have been obvious to one having ordinary skill in the art to utilize Applicant's admission by providing the PVC mount in the invention of Treglown to have static cling property.

With regards to the mount be transparent, the mount of Treglown can be polyethylene which is well known to be transparent.

Claim Rejections - 35 USC § 112

8. Claims 1, 4-914-18 and 25-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrase "by the well-known "cling" properties of such PVC which has been rendered soft by plasticizer additives" is found to be new matter as support for said could not be located in the specification, as originally filed.

Specification

9. The amendment filed July 26, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The amendment to paragraph-[0035] and the deletion of paragraphs [0042], [0043], [0047] are found to be new matter because it changes the scope of the application, as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

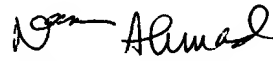
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 10/29/05
Primary Examiner
Art Unit 1772

N. Ahmad.
October 29, 2005.